

asserts that no new matter is entered as such feature is disclosed in Claims 9 and 39 and in paragraph [0046] of the Substitute Specification.

### Remarks

#### The Rejection of Claims 1-11 and 29-43 under 35 U.S.C. §112

The Examiner rejected Claims 1 and 29 and those claims depending therefrom under 35 U.S.C. §112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Specifically, the Examiner objected to the use of the phrase "in particular" in Claims 1 and 29. Applicant has amended the Claims 1 and 29 to remove the phrase "in particular".

With regard to the rejection of Claim 31, Applicant has amended the claim to recite that an optical system, "is a member selected from the group consisting of a sector optical system, a sector polarization optical system, a sector stop, a sector phase stop and a sector phase filter, and is associated with the additional light source."

With regard to the rejection of Claim 32, Applicant has amended the Claims to recite that the optical system is arranged in "a" Fourier plane.

Finally, with regard to Claim 42, Applicant has amended the Claim to recite "scanner detector".

#### The Rejection of Claims 1-4, 9-11, 29-34 and 39-43 under 35 U.S.C. §102

The Examiner rejected Claims 1-4 and 9-11 as being anticipated by U.S. Patent No. 5,796,112 (Ichie) and Claims 1, 10, 29-34 and 39-43 as being anticipated by U.S. Patent No. 5,535,052 (Jörgens). Applicant respectfully traverses these rejections and requests reconsideration.

#### U.S. Patent No. 5,796,112 (Ichie)

With regard to the rejection of Claim 1, and those depending therefrom, Ichie does not disclose all of the elements of Claim 1 as required under 35 U.S.C. §102. Ichie relates to a fluorescent microscope for detecting fluorescence emanating from a specimen. While the detectors disclosed by Ichie may inherently receive fugitive non-fluorescent transmitted light, they are not configured for actually detecting non-fluorescent transmitted light. Indeed, column 15, lines 32-54 of the Ichie specification specifically states, that detectors (PMT's) 19a-c and 20a-c all detect fluorescence. There is literally no indication that the invention disclosed by Ichie comprises transmitted light detectors. Additionally, Ichie does not disclose the limitation of simultaneously

detecting both fluorescent and transmitted light via fluorescent and transmitted light detectors. Furthermore, all embodiments disclosed by Ichie each comprise a barrier filter 18 so that only fluorescent light may be detected by the detectors (see col. 8, lines 49-52 and Col. 11, lines 44-54). Consequently, Applicant respectfully requests reconsideration of the rejection which action is courteously requested.

U.S. Patent No. 5,535,052 (Jörgens)

With regard to the rejection of Claim 1, and those depending therefrom, under 35 U.S.C. §102 in view of Jörgens, Applicant has amended Claim 1 to include the limitations of Claim 2 not disclosed by Jörgens.

With regard to the rejection of Claim 29, and those depending therefrom under 35 U.S.C. §102 in view of Jörgens, Applicant has amended the claim to include the limitation that the additional light source is operatively arranged to illuminate a specimen. Applicant respectfully traverses the rejection inasmuch as it may apply to amended Claim 29. Jörgens does not disclose a confocal microscope comprising an additional light source operatively arranged on the side of the specimen facing away from the light source for illuminating a specimen as required by Claim 29. Jörgens teaches additional light sources D and E operatively arranged on the side of the specimen facing the light source. Additionally, while Jörgens teaches transmitted light illuminating device 28, such structure is not adapted for illuminating a specimen. Hence, Applicant respectfully requests reconsideration of the rejection inasmuch as it may apply to amended Claim 29 and those claims depending therefrom.

The Rejection of Claims 5-8 and 35 under 35 U.S.C. §103

The Examiner rejected dependent Claims 5-8 and 35 under 35 U.S.C. §103 as being obvious in view of Ichie, Jörgens and German Patent Document No. DE 42 806 (Kapitza). Applicant respectfully traverses the rejection inasmuch as the rejection may apply to amended Claims 1 and 29, and those claims depending therefrom.

First, Applicant submits that the above-identified claims rejected by the Examiner all depend from allowable non-obvious independent claims. Under U.S. patent law, where an independent claim is found to be non-obvious, those claims depending therefrom are also non-obvious. Thus, it necessarily follows that Claims 5-8 and 35 are non-obvious.

Second, Ichie relates to a fluorescent microscope for detecting fluorescence emanating from a

specimen. The detectors disclosed by Ichie are not configured for detecting non-fluorescent transmitted light. Hence, Ichie does not implicitly or explicitly contain any teaching, suggestion or motivation to combine his teachings with those of others to simultaneously detect transmitted and fluorescent light. In all actuality, the fact that Ichie does not disclose simultaneous detection of fluorescent and transmitted light serves to teach away from the combination suggested by the Examiner. Hence, one having skill in the art would not have been motivated to combine the teachings of Ichie with those of Kapitza or Jörgens to create the invention of Claims 5-8 or 35.

Third, with particular reference to Claims 5-8, the invention disclosed by Kapitza is not capable of allowing the simultaneous detection of both fluorescent and transmitted light. Hence, the combination or modification suggested by the Examiner would not result in the microscope of the present invention since neither Ichie nor Kapitza are capable of simultaneously detecting both transmitted and fluorescent light. Hence, Claims 5-8 are non-obvious.

Finally, with specific regard to Claim 35, Jörgens does not meet all the limitations of newly amended Claims 29, and hence does not meet all the limitations of dependent Claims 35. Additionally, as indicated above, Kapitza does not disclose a microscope assemblage capable of simultaneously detecting both transmitted and fluorescent light. Hence, one would not have been motivated to make the combination suggested by the Examiner and even if such combination or modification were made, the combination would not result in the invention of amended Claim 29 or dependent Claim 35.

For the reasons set forth above, Applicant respectfully requests reconsideration of the rejection.

Conclusion

Applicant respectfully submits that the present application is now in condition for allowance, which action is courteously requested.

Respectfully submitted,



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